

**REMARKS**

Claims 15, 18-20, 22, 26-27, 30-39, 42, and 44-52 are currently pending in the application. Claim 15 has been amended and claim 17 has been cancelled. Applicants note with appreciation the indication by the Examiner that claims 30-39, 42, 44, 45, 50, and 51 are allowable over the prior art of record.

**Telephone Interview**

Applicant appreciates the courtesy extended by the Examiner in granting a telephone interview on August 24, 2004.

In her Office Action, the Examiner asserted that Applicants had not complied with one or more conditions for receiving a benefit of an earlier filing date under 35 U.S.C. 120 because they failed to present a petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 120 as required under 37 C.F.R. 1.78(a)(2). The Examiner stated that the benefit claim filed on March 9, 2004 was not entered because the required reference was not timely filed within the time period set forth in 37 C.F.R. 1.78(a)(2) or (a)(5).

In reviewing the application file, Applicants determined that the benefit claim to priority was timely filed within the time period because it was submitted in a preliminary amendment deposited on August 8, 2001, which is within four months of the actual filing date of the application (July 3, 2001). Applicants' representative contacted the Examiner and explained that the benefit claim to priority was timely filed within the time period. In the Telephone Interview held with the Examiner on August 24, 2004, and in the Examiner's Interview Summary, the Examiner agreed that the correction was done in a timely fashion as required by 37 CFR 1.78(a)(2). Therefore, it is Applicants' belief that the effective filing date of this application is June 25, 1993 because priority was timely filed within the required time period.

During the Telephone Interview, the Examiner pointed out possible issues with respect to the addition of incorporation by reference to Application Serial No. 08/905,654 and Application Serial No. 08/082,689, which might raise some objection to new matter.

Applicants believe that the incorporation by reference phrase does not constitute new matter. The incorporation by reference phrase was present in the originally filed application papers in the Patent Application Transmittal Letter, page 3, which incorporated the contents of each of the related applications by reference in their entirety. While the 08/479,339 application was incorrectly referred to as the 08/479,337 application, this error was timely corrected within the appropriate time period as discussed above. Therefore, Applicants respectfully submit that because the incorporation phrase was present in the preliminary amendment filed concurrently with the present application and the cross-reference to related applications was only amended to correct the typographical error in the application number for the 08/479,339 application, that the incorporation by reference phrase does not constitute new matter as it was present in the application as filed.

However, if the Examiner determines that the incorporation by reference phrase does constitute new matter notwithstanding the above arguments presented by Applicants, and further, if all other issues in the application are resolved, permission is given to the Examiner to correct the cross-reference to related applications section and remove the incorporation by reference phrase in an Examiner's Amendment.

In her interview summary, the Examiner noted that there could be some issue as to the support of all of the claims of record all the way back to the original Serial No. 08/082,689 that could leave Fan available for a reference. Applicants have reviewed the disclosures of the originally filed 08/082,689 application and the disclosure of the instant application, which is a continuation-in-part of the 08/082,689 application. Applicant believes that the claims presented in the instant application are fully supported by the 08/082,689 application and thus have an effective date as of the filing date of this

application. The 08/479,339 application, which is a continuation-in-part of the 08/082,689 application, contains the same disclosure as 08/905,654 which is a division of the 08/479,339 application and the instant application, which is a division of the 08/905,654 application. The continuation-in-part application provides a substantially similar disclosure to that of the 08/082,689 application, but adds further disclosure to a second photocurable (or overcoat layer) (See the specification, page 2, lines 10-32 and page 12, line 7 through line 13, line 3.) The claims in the instant application do not provide a limitation for the second overcoat layer and are therefore believed to be afforded the effective filing date of the 08/082,689 application – June 25, 1993. Thus Applicants respectfully submit that the claims are fully supported by the 08/082,689 application and the Fan reference is not prior art for any of the pending claims of the instant application.

Applicant believes that the above discussion also adequately responds to the arguments presented by the Examiner in paragraphs 1-3 of her office action dated July 13, 2004.

#### **Declaration of Rustom Kanga**

Examiner notes that the Exhibits A through G attached to the Declaration of Rustom Kanga (hereinafter the “Decl. of Kanga”) are not present in the filed electronic copies set forth in the USPTO IFW system and the Examiner does not know if there are tags that are missing or if the tags were not copied from the papers submitted by Applicants.

Applicants assure the Examiner that the Exhibits were properly tagged when submitted with the Decl. of Kanga. However, so that the Examiner may properly consider the Decl. of Kanga, Applicants are submitting a replacement Decl. of Kanga that refers to specific pages in a single attached Exhibit, rather than in separate exhibits and to refer to page numbers in the one exhibit. Applicants are hopeful that this approach will

enable the Examiner to fully consider the Decl. of Kanga with all of its supporting materials.

**35 U.S.C. §102(e)/35 U.S.C. §103(a) rejection**

Claims 15, 17-20, 22, 26-27, 46-49, and 52 stand rejected under 35 U.S.C. §102(e) as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as being unpatentable over Fan (6,238,837). The Examiner maintains that Fan has a filing date of May 1, 1995 which is before the oldest effective filing date of the instant application, i.e., August 4, 1997 and that Fan is thus seen as prior art under 35 U.S.C. 102 (e).

As discussed in more detail above, it is Applicants' belief that the effective filing date of this application is June 25, 1993 because priority was timely filed within the required time period. Therefore, Applicants respectfully submit that Fan is not available as patent art against the instant application because it does not have a filing date prior to June 25, 1993. Because Fan cannot be used as prior art against the claims of the instant application, Applicants respectfully request that the rejection of claims 15, 18-20, 22, 26-27, 46-49, and 52 under 35 U.S.C. §102(e) as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as being unpatentable over Fan (6,238,837) be withdrawn.

**35 U.S.C. §103 Rejection**

Claim 15 stands rejected under 35 U.S.C. §103 as being unpatentable over Scott Paper Company in view of the Murphy Declaration and further in view of Law et al.

The Examiner states that in view of Mr. Murphy's expert opinion that the disclosure of one IR ablatable layer in the materials of the 1993 application as being sufficient to give support for the instant claims which have no binder in common with the disclosure of the sole IR ablatable material disclosed functional enough to form a working plate, than the disclosure of Scott Paper Company is sufficient to make obvious the use of any binders used in non-UV laser radiation ablatable layers known in the art before the 1993 disclosure as well as any ultraviolet lithographic negative acting

presensitized plates known before the 1993 disclosure, because the predictability of the art at the filing of the 1993 disclosure is so predictable to allow such breadth of obviousness.

Applicant respectfully disagrees. Claim 15, as it is presently drafted, does in fact have a binder in common with the disclosure of the IR ablatable material “disclosed functional enough to form a working plate.” Claim 15 and Example 3 of the application (page 17, lines 27+ of the specification) both provide for the use of polyamide as a binder of the laser ablatable layer.

Claim 15 has also been amended in the present response to specifically refer to a photosensitive printing element and to include the limitation of cancelled claim 17, which claim was not included in the rejection of claim 15 over Scott Paper Company in view of the Murphy declaration and Law et al.. Claim 15 was also amended in the previous response (mailed on March 5, 2004) to change “photopolymerizable” to “photocurable” and to change “infrared radiation” to “laser radiation.” Thus, instant claim 15 is not limited to infrared laser radiation as is inferred by the Examiner, but is open to other wavelengths of laser radiation. Furthermore, the Decl. of Kanga explains that the June 1993 application does not require that a particular wavelength of radiation be used but repeatedly refers to ablation at a “selected wavelength” or at an “appropriate wavelength” (see Decl. of Kanga ¶8(a)). The Decl. of Kanga further explains that the June 1993 application provides examples using both UV laser radiation and infrared laser radiation (see Decl. of Kanga ¶8(b)), i.e. an “appropriate wavelength” as demonstrated by the examples.

Applicant respectfully submits that Law et al. does not describe a photosensitive printing element but rather describes an optical recording composition wherein the ablative optical recording devices are exposed to laser light causing pits or holes to be formed in the absorbing layer, which information can be read in reflection by means of laser light. Furthermore, Law et al. does not teach or suggest a layer of a photocurable

composition. While Law et al. does describe a laser ablatable layer, the laser ablatable layer of Law et al. is deposited on a reflective substrate, such as a reflective glass substrate (see column 6, lines 66-67) not on a layer of photocurable composition.

In addition, Mr. Murphy's declaration is directed to a prior version of claim 15, which claim has been amended multiple times to distinguish the claimed invention over the prior art of record. Applicant respectfully submits that while Mr. Murphy's declaration may demonstrate the breadth of obviousness as to previous versions of claim 15, the present version of claim 15 contains many features that were not contained in the prior version of the claim as discussed in the previous paragraphs and is thus distinguishable from the prior art of record.

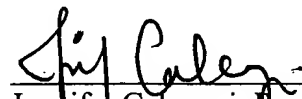
For all of these reasons, it is believed that present claim 15 is not anticipated or rendered obvious by the prior art.

### **Conclusion**

Applicant believes that the foregoing is a complete response to all of the objections and rejections raised by the Examiner and that all of the claims of the instant application are now in condition for allowance. Accordingly, an indication of allowability and an early Notice of Allowance is respectfully requested.

If the Examiner feels that a telephonic interview would be helpful, she is requested to contact the undersigned at (203) 575-2648.

Respectfully Submitted,



Jennifer Calcagni, Reg. No. 50,207  
Carmody & Torrance, LLP  
50 Leavenworth Street  
Waterbury, CT. 06721-1110  
(203) 575-2648